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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/308,219	09/19/1994	MARC ALIZON	3495.001020	4832
22852	7590	06/17/2004		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			EXAMINER FREDMAN, JEFFREY NORMAN	
			ART UNIT 1637	PAPER NUMBER

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 08/308,219	Applicant(s) ALIZON ET AL.	
	Examiner Jeffrey Fredman	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-22 is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 23-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In analysis of the claims for compliance with the written description requirement of 35 U.S.C. 112, first paragraph, the written description guidelines note regarding genus/species situations that "Satisfactory disclosure of a ``representative number" depends on whether one of skill in the art would recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus in view of the species disclosed." (See: Federal Register: December 21, 1999 (Volume 64, Number 244), revised guidelines for written description.)

Claims 23-28 encompass a genus of nucleic acids which are different from those disclosed in the specification due to the use of the hybridizing language. The genus includes variants for which no written description is provided in the specification. This large genus is represented in the specification by only the particularly described sequences as shown in the figures of the specification. Thus, applicant has express

possession of only one particular HIV-1 genomic sequence, that given in claim 17, in a genus which comprises hundreds of millions of different possibilities. Here, no common element or attributes of the sequences are disclosed which would be conserved among the different members of the genus. Further, these claims encompass alternately spliced versions of the proteins, allelic variants including insertions and mutations, inactive precursor proteins which have a removable amino terminal end, and only specific amino acid sequences have been provided. No written description of alleles, of upstream or downstream regions containing additional sequence, or of alternative splice variants has been provided in the specification.

It is noted in the recently decided case The Regents of the University of California v. Eli Lilly and Co. 43 USPQ2d 1398 (Fed. Cir. 1997) decision by the CAFC that

"A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is. See *Fiers*, 984 F.2d at 1169- 71, 25 USPQ2d at 1605- 06 (discussing *Amgen*). It is only a definition of a useful result rather than a definition of what achieves that result. Many such genes may achieve that result. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372- 73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material. "

In the current situation, the definition of the HIV-1 sequences as anything which "hybridizes to the DNA of claim 17" lack any specific structure. This is precisely the

situation of naming a type of material which is generally known to likely exist, but, except for the specific sequence of claim 17, is in the absence of knowledge of the material composition and fails to provide descriptive support for the generic claim to any sequence which "hybridizes to the DNA of claim 17".

It is noted that in Fiers v. Sugano (25 USPQ2d, 1601), the Fed. Cir. concluded that

"...if inventor is unable to envision detailed chemical structure of DNA sequence coding for specific protein, as well as method of obtaining it, then conception is not achieved until reduction to practice has occurred, that is, until after gene has been isolated...conception of any chemical substance, requires definition of that substance other than by its functional utility."

The current situation is a definition of the compound solely by its functional utility, as a sequence which "hybridizes to the DNA of claim 17", without any definition of the particular changes permitted by the "hybridization" language.

In the instant application, certain specific SEQ ID NOs are described. Also, in Vas-Cath Inc. v. Mahurkar (19 USPQ2d 1111, CAFC 1991), it was concluded that:

"...applicant must also convey, with reasonable clarity to those skilled in art, that applicant, as of filing date sought, was in possession of invention, with invention being, for purposes of "written description" inquiry, whatever is presently claimed."

In the application at the time of filing, there is no record or description which would demonstrate conception of any nucleic acids other than those expressly disclosed which "hybridizes to the DNA of claim 17". Therefore, the claims fail to meet the written description requirement by encompassing sequences which are not described in the specification.

Allowable Subject Matter

3. Claims 17-22 are allowed.
4. The following is a statement of reasons for the indication of allowable subject matter: These sequences are novel and unobvious because the Chang patent expressly excludes a region of the sequence now claimed. The SstI fragment is absent from Chang and from Chang's clone, rendering Chang unable to anticipate or make obvious claims which encompass this SstI fragment region. Applicant correctly contends that these claims encompass that region and are therefore unobvious over Chang. Therefore, these claims are novel and unobvious.

Response to Arguments

5. Applicant's arguments filed May 18, 2004 have been fully considered but they are not persuasive.

Applicant argues that there is sufficient description of species in the claimed genus to overcome the written description rejection and Applicant relies upon the Example 9 of the written description guidelines and the Enzo decision to support this position.

First, Applicant is incorrectly applying the fact pattern of Example 9 to the current facts for a number of reasons. The claim in example 9 incorporates two elements absent from the current claim. The claim incorporates specific hybridization conditions. This element is lacking from Applicant's claims and so the facts are therefore significantly different. The absence of specific hybridization conditions differentiates the claims because these conditions, as related to the particular claimed SEQ ID NO: are

responsible for the conclusion that there would be insubstantial variation. No such conditions are in the currently rejected claims.

Second, when Applicant relies upon the analysis of the written description guidelines, this analysis is based upon the assumption that there will be insubstantial variation, as noted in many of the examples including example 9. However, Applicant's analysis is flawed since there is no expectation in the instant case of insubstantial variation because the functional limitation devolves solely to the ability of the nucleic acid to hybridize. This is not like example 9, where the functional limitation involved a protein which retained adenylate cyclase activity. In the example 9 case, the argument of insubstantial variation was that there was an expectation that stringently hybridizing proteins which retained the specific function of stimulating adenylate cyclase would differ insubstantially.

In the current case, there is no such expectation of insubstantial variation. There is NO functional requirement that is tied to structure whatsoever, similar to the adenylate cyclase activity. Hybridization is an inherent capability of nucleic acids, and amplification, in particular, can be achieved with non specific primers. Many methods, ranging from ARMS to differential display, specifically rely on the fact that nonspecific unrelated nucleic acids are capable of amplifying specific targets. So the argument by Applicant that there would be insubstantial variation is not correct since the function of hybridizing and amplifying does not limit the nucleic acid in any significant way.

With regard to Applicant's analysis of the Enzo decision, Enzo simply remanded all of the issues to the district court while referring to the guidelines. Since the USPTO

takes the position that Applicant's claims do not comply with the written description guidelines, for the reasons given above, the Enzo analysis is not correctly applied. Applicant argues that because claim 17, which is a claim drawn to a specific sequence is described, then any claim which is drawn to fragments which hybridize to the sequence of claim 17 are equally described. This result is not correct for the reasons given above. There is no expectation that a hybridizing fragment differs with only insubstantial variation. A single species disclosure will not support this broad generic set of claims.

Therefore, since the claims differ very substantially from those in Example 9 of the written description guidelines and fail to comply with the guidance given by the Federal Circuit, the rejection under written description is maintained.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

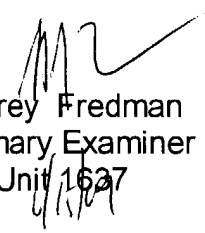
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey Fredman
Primary Examiner
Art Unit 1637